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IN RE: O. YOKOMIZO, et al.
SERIAL NO. 08/470,424 : PETITION UNDER 37 CFR 1.181
FILED: June 6, 1995 :
DOCKET # 501.25507CX5

FOR: FUEL ASSEMBLY AND NUCLEAR REACTOR

This is in response to the petition filed on February 23, 2004 for entry of an amended Appeal Brief in response to a Notice of Non-Compliance.

The petition is GRANTED to the extent discussed below.

FACTS

Applicant filed a Brief under 37 CFR 1.192 on October 26, 2001 along with an amendment to a claim. On January 23, 2002, an advisory action was mailed entering the amendment.

On June 20, 2003 a notice of defective brief was mailed indicating that the brief filed on October 26, 2001 1.) improperly refers to reference numbers in the specification, 2.) incorporates new matter in the summary of the invention, 3.) includes an improper statement of issues, 4.) does not provide arguments as to why the claims do not stand or fall, and 5.) does not provide arguments under separate headings.

An amendment to correct the dependency of a claim was filed on July 21, 2003. That amendment was entered in an advisory action mailed on August 7, 2003

A new Brief was received on July 21, 2003

A letter was mailed on December 18, 2003 indicating that the amended brief was still defective for three reasons: 1.) The inclusion of material in the Summary of the Invention that was not found in the original specification; 2.) failure to provide separate arguments for each claims indicated as standing or falling separately from other claims; and 3.) improper headings of some of the issues.

On January 22, 2004, a letter was mailed to the applicant indicating that because of the inordinate amount of time that passed between the filing of the amended Brief and the letter of non-compliance mailed on December 18, 2003, the response would not be considered inadvertent and a new 1 month time period would be restarted to provide an amended Brief in response to the latest notice of non-compliance.

On February 23, 2004 an amended Brief was filed.

On March 22, 2005 a Communication re: Appeal was mailed to the applicant indicating that the Appeal was dismissed for failure to provide a corrected Brief. Since there were no allowable claims, the application was held abandoned.

DISCUSSION

Applicant petitions that extraneous information in the Summary of the Invention should not be placed under a separate heading, as suggested by the examiner.

With respect to the subject matter added to the Summary of the Invention that is not found or supported by the specification, applicant argues that this information will assist the Board in understanding the skill in the art. Although providing such information is not prohibited and may be useful to the members of the Board, such information should not be included in the Summary of the Invention. In this case, the examiner has alleged that the specification does not provide support for the invention claimed and providing information in the summary of the invention that is not supported by the original disclosure only serves to confuse matters. It is the applicant's understanding that this subject matter is "inherent" in the summary of the invention, contrary to the examiner's opinion that it is not. Since this issue centers on a rejection of the claim, it is appealable and therefore not properly before the Director of a Technology Center. Therefore, the petition is granted on this issue to the extent that it will be brought before the Board and an appealed matter to be decided by the Board.

With respect to the issue of providing separate arguments for each claim standing or falling separate from other claims, the rules and MPEP are clear as to this requirement. 37 CFR 1.192(c)(7) specifically states:

"For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out

differences in what the claims cover is not an argument as to why the claims are separately patentable.”(emphasis added).

The MPEP further discusses this requirement and states in section 1206 under Appeal Brief Content :

“It should be noted that 37 CFR 1.192(c)(7) requires the appellant to perform two affirmative acts in his or her brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered. The appellant must (A) state that the claims do not stand or fall together and (B) present arguments why the claims subject to the same rejection are separately patentable. Where the appellant does neither, the claims will be treated as standing or falling together. Where, however, the appellant (A) omits the statement required by 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief, or (B) includes the statement required by 37 CFR 1.192(c)(7) to the effect that one or more claims do not stand or fall together (i.e., that they are separately patentable) yet does not offer argument in support thereof in the “Argument” section of the brief, the appellant should be notified of the noncompliance as per 37 CFR 1.192(d). Ex parte Schier, 21 USPQ2d 1016 (Bd. Pat. App. & Int. 1991); Ex parte Ohsumi, 21 USPQ2d 1020 (Bd. Pat. App. & Int. 1991).”(emphasis added).

Thus, it has been determined that the examiner has followed the correct procedures in handling this matter. The applicant argues in his petition that 37 CFR 1.192(c)(7) specifically provides a solution to such non-compliance in that in the event that such section has not been complied with, "the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone". In this case, the applicant has been notified of the deficiencies and the appellant has responded by electing not to argue the claims identified by the examiner independently. Therefore, the issue is considered closed and the examiners answer will only be directed to the claims that were sufficiently argued by appellant.

With respect to the issue of improper headings of the issues, a review of the Brief does indicate that the statement of the issues is correct and under the separate head of each issue. Although confusing as written, the Brief does at least refer back to a specific statement of the specific issue. For this reason, the Board should be able easily determine the specific issue being argued.

With respect to applicant's concerns over the lack of timeliness of the processing of this application, a review of the processing history of this application was made and it has been determined that the delay in acting on the application after the abandonment was rescinded was not a result of the examiner's actions, but rather a processing error that failed to notify the examiner of the rescinded abandonment of this file. Applicant is encouraged in the future to alert the Office when it appears that processing of an application is unusually long. This may be done by telephoning the examiner, his supervisory patent examiner or filing a status request.

The petition is **GRANTED**.

Inasmuch as the Brief filed February 23, 2004 is deemed sufficient, the Office communication mailed March 22, 2005 is hereby vacated. The holding of abandonment indicated in the letter dated March 22, 2005 is therefore withdrawn.

The application is being forwarded to the examiner for preparation of an examiners answer in accordance with this decision.

Any question concerning this decision should be referred to SPE Michael Carone at 703 306-4198.



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/mjc: